

REMARKS

Reconsideration of the above-identified application, as amended, is respectfully requested.

In the Official Action dated April 9, 2003, the Examiner rejected Claims 6, 16-19, 21-32 and 34-41 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Particularly the Examiner indicated phraseology in Claims 16 and 29 that allegedly lack proper antecedent basis and further, that claims 6, 21 and 34 depend upon canceled claims.

In the Official Action, the Examiner further rejected Claims 1-4, 6-19, 21-32 and 34-41 under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,408,278 to Carney et al. ("Carney") in view of U.S. Patent No. 6,334,109 to Kanevsky et al. ("Kanevsky").

The Examiner additionally has made these rejections FINAL.

In response to the 35 U.S.C. §112, applicants amend each of Claims 16 and 29 to set forth the singular form "physical characteristic" to provide the proper antecedent basis for this term later in each of Claims 16 and 29. Further, applicants amend each of Claims 6, 21 and 34 to properly set forth the respective dependency of these claims. In view of the amendments provided herein, applicants respectfully request the Examiner to withdraw the rejection of claims 6, 16, 21, 29 and 34 under 35 USC §112, second paragraph.

With respect to the rejection of Claims 1-4, 6-19, 21-32 and 34-41 under 35 U.S.C. §103(a) as allegedly being obvious over Carney in view of Kanevsky applicants respectfully disagree for the following reason.

The cited reference to Kanevsky, while being filed October 21, 1999 qualifies this reference as prior art under 35 U.S.C. §102(e). However, Applicants note that Kanevsky is not prior art as to the present application because Kanevsky and the present application are assigned to the same corporation, IBM Corporation. Applicants submit that the refiling of the present application as a Continued Prosecution Application on June 18, 2002 brings the subject application under the rubric of the amendments made to the Patent Law in the American Inventors Protection Act of 1999. That Act, enacted November 29, 1999, amends 35 U.S.C. §103(c) such that subject matter developed by another person which qualifies as prior art under 35 U.S.C. §102(e) does not preclude patentability where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an application of assignment to the same person.

That this section applies to the instant application is established by the Guidelines concerning the implementation of changes to 35 U.S.C. §§102(g) and 103(c) published in the Official Gazette on April 11, 2000. Those Guidelines includes the statement that the amendment to §103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 C.F.R. §1.53(d), continued prosecution applications filed under 37 C.F.R. §1.53(b) and reissues. In view of the refiling of the present application on June 8, 2002 as a CPA, under 37

C.F.R. §1.53(d), applicants benefit from the statutory restraints imposed in the amendment to §103(c).

That the claims of the present application are patentable over the rejection of record is established by the fact that Kanevsky is, on its face, assigned to International Business Machines. The instant application is also assigned to International Business Machines. The Assignment of the instant application to International Business Machines by the applicants of the present application was mailed October 21, 1999 to the USPTO for recording. The Assignment was recorded by the USPTO on October 21, 1999 at Reel 010335, Frame 0093.

U.S. Patent 6,334,109 to Kanevsky issued December 25, 2001. The present application is entitled to the benefit of the filing date of October 21, 1999. As such, the outstanding rejection of the claims of the present application applies the Kanevsky patent predicated upon its availability as a reference under 35 U.S.C. §102(e) in that this is the only subsection of 35 U.S.C. §102 whose requirements are met by this patent.

In view of the requirements of 35 U.S.C. §103(c), as amended November 29, 1999, which apply to the instant CPA, the principal Kanevsky reference cannot preclude patentability under 35 U.S.C. §103, the section upon which the claims of the present application have been rejected. Thus, the claims of the present application are patentable over the outstanding rejection of record. Reconsideration and removal of this ground of rejection is therefore deemed appropriate. Such action is respectfully urged.


For the reasons advanced above, Claims 1, 16 and 29 patentably distinguish over the prior art and are allowable. Claims 2-4 and 6-15 are dependent from and are allowable with Claim 1, and Claims 17-19, and 21-28 are dependent from and are

allowable with Claim 16 and Claims 20-32 and 34-41 are dependent from and are allowable with Claim 29.

Accordingly, the Examiner is requested to reconsider and to withdraw the rejection of, and to allow, Claims 1-4, 6-19, 21-32 and 34-41 under 35 U.S.C. §103(a).

In summary, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance be issued. If the Examiner believes that a telephone conference with the Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,


Steven Fischman
Registration No. 34,594

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343

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